

REMARKS

In the Office Action of March 26, 2004, the Examiner rejected claims 1 through 13 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse the rejection and request reconsideration.

I. Section 101 Rejection.

In the Office Action of March 26, 2004, the Examiner stated that “the invention is not implemented on a specific apparatus; therefore, the invention is not directed to the technological arts.” Independent claims 1 and 8 have been amended to clarify that, as recognized by the Examiner in the Office Action, the claimed methods are “computer based.” Applicants further note that at least claims 6 and 13, as originally presented, include express language directly tying the invention to the technological arts. Applicants submit that in light of this clarification, the claims are clearly directed to an invention in the “technological arts,” in conformance with the requirements of Section 101.

The Office Action also seems to suggest that the claimed methods merely manipulate data in an abstract manner. Applicants strongly disagree, as the claimed invention produces a useful, concrete and tangible result—i.e., “opening option trading.” In AT&T Corp. v. Excel Comm., the Court of Appeals for the Federal Circuit found that claims related to deriving a billing value using a simple Boolean mathematical principle constituted patentable subject matter under 35 U.S.C. § 101. 50 U.S.P.Q.2d 1447, 1451-52 (Fed. Cir. 1999). Thus, as stated by the U.S. Patent and Trademark Office, “an abstract

idea when practically applied to produce a useful, concrete and tangible result satisfies Section 101.” (See, e.g., <http://www.uspto.gov/web/menu/pbmethod/trangmaterials.ppt>).

Similarly, in State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368 (Fed. Cir. 1998), the Federal Circuit Court held that in order to meet the utility requirement imposed by 35 U.S.C. § 101, an invention must produce a “useful, concrete and tangible result,” State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Applying this test, the State Street Court held that the “transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces “a useful, concrete and tangible result” -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” State Street, 149 F.3d at 1373, 47 USPQ2d at 1601. The recitation in claims 1 through 13 of the specific application of the computer based method to achieve the useful, concrete and tangible result of opening trading satisfies the utility requirement of Section 101.

II. Conclusion

In light of the foregoing, applicants submit that claims 1 through 13 are i) directed to the technological arts; and ii) have utility. Thus, claims 1 through 13 satisfy the requirements of Section 101.


In light of the foregoing, applicants submit that the present application is in condition for allowance and notice to that affect is hereby requested. If the Examiner

believes that further dialog would help move the present application to issuance, she is invited to telephone the undersigned at 312/913-2119.

Respectfully submitted,
**McDonnell Boehnen Hulbert &
Berghoff**

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By :


Matthew J. Sampson
Reg. No. 35,999